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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,948	01/11/2007	Christian M. Stich	1034193-000051	8426
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EXAMINER				
LEE, MARINA				
ART UNIT		PAPER NUMBER		
2192				
NOTIFICATION DATE		DELIVERY MODE		
09/24/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com  
offserv@bipc.com

### Office Action Summary

**Application No.**

10/574,948

**Applicant(s)**

STICH ET AL.

**Examiner**

MARINA LEE

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-16 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 07 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/22)  
Paper No(s)/Mail Date 4/7/2006; 1/11/2007  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to the Preliminary Amendment filed on April 7, 2006.
2. Claims 1-10 have been amended. Claims 11-16 have been added. Thus, claims 1-16 are pending and are presented for examination.

#### ***Claim Objections***

3. Claims 1-5 and 11-13 are objected to because of the following informalities:

As to claim 1 (line 3), recites to include limitation "opponents arranged" should be changed to --components arranged--. Appropriate correction is required.

Claims 2-5 and 11-13 are also objected to for depended upon the objection of base claim 1.

#### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-5 and 11-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 1, recites to include, "A system for automatically... a system planning tool ..." does not comprise hardware component (no physical transformation) in order to realize the functionality of the system. The "system" without such hardware component may be broadly interpreted as data structures

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representing descriptive material per se or computer programming representing computer listing per se – functional descriptive material under 35 USC § 101.

See MPEP 2106.01(I).

Claims 2-5 and 11-13 recite the limitations that do not cure the deficiency of the base claim 1, which regarding to the rejection of non-statutory under 35 USC 101. Therefore, they are also rejected for the same reason.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-16 are rejected under 35 U.S.C. 102 (b) as being anticipated by Gonzalez et al. (US 2003/0200149 A1, hereinafter Gonzalez).

**As to claim 1**, Gonzalez discloses a system for automatically installing and configuring functionalities, stored in installation, verification and/or configuration files, for system components arranged in a distributed network – *(e.g. Network Installation Package (NIP) Manager 112 automatically generates network installation package 78 for system 10 or network 10 or SAN 10 which includes multiple workstations 12, 13, and 14 –See at least [0027-0030] and [0020-0023]), where*

- a system planning tool is used to create, check and configure the installation, verification and/or configuration files for the respective system components, --(e.g. *Network Installation Package (NIP) Manager 112 automatically generates network installation package 78 for Storage Area Networks (SAN) 110 – See at least [0027-0030] and [0020-0023]*)

- the system planning tool transmits the installation, verification and/or configuration files for installation in the system components – (e.g. *the network installation package 78 transmits to the customer via internet – see at least [0027-0028] and [0024]*),

- the respective system components automatically checks and configures the required installation, verification and/or configuration files in a prescribed order and manner – (e.g. *network installation package 78 loaded in to RAM 56 for execution by CPU 54 at the customer site – see at least [0044]*), and

- following the configuration of the system components an overall systems is formed – (e.g. *installing the remaining components for SAN 10 – see at least [0044]*).

**As to claim 6**, Gonzalez discloses a method for automatically installing and configuring functionalities, stored in installation, verification and/or configuration files, for system components arranged in a distributed network – (e.g. *Network Installation Package (NIP) Manager 112 automatically generates network installation package 78 for system 10 or network 10 or SAN 10 which includes multiple workstations 12, 13, and 14 –See at least [0027-0030] and [0020-0023]*), where

- a system planning tool is used to create, check and configure the installation, verification and/or configuration files for the respective system components, --(e.g. *Network Installation Package (NIP) Manager 112 automatically generates network installation package 78 for Storage Area Networks (SAN) 110 – See at least [0027-0030] and [0020-0023]*)

- the installation, verification and/or configuration files required in the respective system components automatically checks and configures the required installation, verification and/or configuration files in a prescribed order and manner – (e.g. *network installation package 78 loaded in to RAM 56 for execution by CPU 54 at the customer site – see at least [0044]*), and

- the system components are configured to form an overall system – (e.g. *installing the remaining components for SAN 10 – see at least [0044]*).

**As per claims 2 and 7**, Gonzalez also discloses wherein following the configuration of the system components an operational overall system is formed – *see at least [0021-0023] and [0044]*).

**As per claims 3, 8, 11, and 14** Gonzalez also discloses wherein the functionalities stored in installation, verification and/or configuration files are in the form of software packages – (e.g. *the network installation package 78 – see at least [0027-0028]*).

**As per claims 4, 9, 12, and 15**, Gonzalez also discloses wherein the overall system is in the form of a distributed network – *see at least [0020-0024]*, particularly in the form of a distributed automation system – (e.g. *network*

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*installation manager (NIM) push (distributed) software and configuration parameters to the devices – see at least abstract, fig. 1, and [0001]).*

**As per claims 5 and 10**, Gonzalez also discloses wherein the software packages are used to store system component data and setup data for the system components – (e.g. *configuration parameters to be included in the network installation package 78 – see at least [0038] and [0040]*).

**As per claims 13 and 16**, Gonzalez also discloses wherein the overall system is in the form of a distributed network – *see at least [0020-0024]*, particularly in the form of a distributed automation system – (e.g. *network installation manager (NIM) push (distributed) software and configuration parameters to the devices – see at least abstract, fig. 1, and [0001]*).

### **Conclusion**

8. The prior art made of record and not relied upon (cited on 892 form) is considered pertinent to applicant disclosure.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lee whose telephone number is (571) 270-1648. The examiner can normally be reached on M-F (11am-7: 30pm) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information

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for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. L./

Examiner, Art Unit 2192

/Tuan Q. Dam/

Supervisory Patent Examiner, Art Unit 2192